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Confirmation No. 3586

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicants: Wollenberg et al. Examiner: M. Wallenhorst
Serial No.: 10/699,507 Group: Art Unit 1743
Filing Date: October 31, 2003 Docket: T-6298D (538-63)
For: HIGH THROUGHPUT SCREENING Dated: May 14, 2008
METHODS FOR LUBRICATING OIL
COMPOSITIONS

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF SECOND REQUEST FOR REHEARING UNDER 37 C.F.R. §41.52

Sir:

Enclosed please find a SECOND REQUEST FOR REHEARING UNDER 37
C.F.R. §41.52.

Please charge any deficiency as well as any other fee(s) which may become due
under 37 C.F.R. § 1.17 to Deposit Account No. 50-3591. Also, in the event any additional
extensions of time are required, please treat this paper as a petition to extend the time as required
and charge Deposit Account No. 50-3591. TWO (2) COPIES OF THIS SHEET ARE
ENCLOSED.

Respectfully requested.

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SECOND REQUEST FOR REHEARING UNDER 37 C.F.R. §41.52

Sir:

In response to the decision on rehearing rendered by the Board of Patent Appeals and Interferences ("Board") mailed March 19, 2008 in which the Board ordered that the opinion therein is denominated a new Decision on Appeal and further ordered that a second request for rehearing is permitted under 37 C.F.R. §41.52(a)(1), Appellants respectfully request a second rehearing of the decision affirming the rejection under 35 U.S.C. §103 (a) of (1) appealed Claims 1-9, 18-29 and 38 as obvious over Kolosov et al. in view of O'Rear or Tolvanen et al.; (2) appealed Claims 10-13 and 30-33 as obvious over Kolosov et al. in view of O'Rear or Tolvanen et al. and further in view of Garr et al.; and (3) appealed Claims 14-17 and 34-37 as obvious over Kolosov et al. in view of O'Rear or Tolvanen et al. and further in view of Smrcka et al. The following comments are respectfully submitted in order to address the points believed to be misapprehended or overlooked by the Board.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8 (a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postpaid in an envelope, addressed to the: Commissioner for Patents, Alexandria, VA 22313-1450, Mail Stop Appeal Brief-Patents on May 14, 2008.

Dated: May 14, 2008


Bridget Griffin

A. Appealed Claims 1-9, 18 and 19 are non-obvious over Kolosov et al. and O'Rear or Tolvanen et al.

First, with respect to the rejection of appealed Claims 1-9, 18 and 19 as obvious over Kolosov et al. in view of O'Rear or Tolvanen et al., the Board now states that O'Rear and Tolvanen are not removed from consideration in the rejection of Claims 1-9, 18 and 19. Thus, Appellants are now for the first time responding to the points they believe the Board misapprehended or overlooked in making this rejection based on Kolosov et al. in view of O'Rear or Tolvanen et al. Second, the Board is respectfully directed to the following paragraph beginning on line 1 of page 6 of the Board's decision:

“The Board found that Kolosov discloses a high throughput system for measuring numerous properties of lubricant compositions, including viscosity, thermal degradation, aging characteristics, and agglomeration or assemblage of molecules. The Board found that one of ordinary skill in the art would have found these properties useful in determining the storage stability of lubricant compositions. Decision 16:22-17:1; see also Decision 20:1-6. The Board also found that Kolosov contemplates measuring a parameter of a sample at a first time followed by measuring the parameter at a second time and so on during a predetermined period of time. Decision 7:7-10. On rehearing, the Appellants have not pointed to any error in these findings.”

Appellants respectfully believe that the following points in the above paragraph were misapprehended or overlooked. Contrary to the statement by the Board that Appellants have not pointed to any error in the findings that one of ordinary skill in the art would have found the properties disclosed in Kolosov et al. useful in determining the storage stability of lubricant compositions, Appellants have asserted that Kolosov et al. only disclose that the invention can be used to screen a lubricant for a variety of properties and provides no suggestion or motivation in Kolosov et al. of obtaining storage stability data by maintaining each sample at a predetermined temperature for a predetermined time and measuring the storage stability of each sample in a high throughput method. Thus, one skilled in the art would not even look to the disclosure of Kolosov et al. to modify the method disclosed therein and arrive at the presently recited high throughput method for screening lubricating oil additive composition samples, under program control, of appealed Claim 1.

Moreover, it is well established that there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 [82 USPQ2d 1385] (2007) (“To facilitate review, this analysis should be made explicit.”) (*citing Kahn*, 441 F.3d at 988). Instead, the Board simply maintains that one of ordinary skill in the art would have found the properties disclosed in Kolosov et al. useful in determining the storage stability of lubricant compositions and states no reasons of particularity as to why one skilled in the art would look to Kolosov et al. to measure storage stability of a composition containing a lubricating oil additive by “maintaining each composition at a predetermined temperature for a predetermined period of time, measuring the storage stability of the composition and outputting the results”.

Third, the Board is respectfully directed to the following paragraph beginning on line 12 of page 6 of the Board’s decision:

The Examiner found that O’Rear and Tolvanen teach that it is common to measure the storage stability of lubricating oil compositions by maintaining the compositions at a certain temperature for a predetermined period of time. See Ans. 7-8. The Appellants have not pointed to any error in these findings.

We find that one of ordinary skill in the art would have recognized that maintaining a composition at a predetermined temperature for a predetermined time simulates storage conditions. Accordingly, we find that one of ordinary skill in the art would have found it useful to maintain the lubricant compositions disclosed in Kolosov at a predetermined temperature for a predetermined time prior to measuring properties related to storage stability. See *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007) (a person of ordinary skill is also a person of ordinary creativity, not an automaton).

Appellants respectfully believe that the following points in the above paragraph were misapprehended or overlooked. Contrary to the statement by the Board that Appellants have not pointed to any error in the findings that O’Rear and Tolvanen et al. teach that it is common to measure the storage stability of lubricating oil compositions by maintaining the compositions at a certain temperature for a predetermined period of time, Appellants have asserted that O’Rear is merely concerned with forming a blend of lube base oils wherein the lube base oil product has a

greater stability in the absence of additives than the stability of the synthetic lube base oil and has a greater stability in the presence of additives than the non-synthetic lube base oil. Moreover, O'Rear further discloses (1) a Oxidation BN test for measuring resistance to oxidation of a composition containing a lube blend and additives by means of a Dornite-type oxygen absorption apparatus in which the compositions are subjected to one atmosphere of pure oxygen at 340°F and measured for the time it takes to consume 1000 ml of oxygen, i.e., a non automated test which is not carried out for a predetermined time; (2) Oxidator A test which uses the same apparatus as in the Oxidator BN test but the composition contains no additive, i.e., a non automated test which is not carried out for a predetermined time and the composition is a lube oil only; and (3) a method to study the stability of lube base oils during storage by monitoring floc and sediment formation when they are stored in an oven while exposed to air., i.e., a non automated test and the composition is a lube oil only. Accordingly, O'Rear provides no disclosure of testing a composition comprising a lubricating oil additive for storage stability by “maintaining each composition at a predetermined temperature for a predetermined period of time, measuring the storage stability of the composition and outputting the results” as presently recited in appealed Claim 1. As such, even by combining Kolosov et al. with O'Rear, one skilled in the art would not arrive at the high throughput method for screening lubricating oil additive composition samples, under program control, as presently recited in appealed Claim 1.

Tolvanen et al. is no more relevant a reference than O'Rear. Tolvanen et al. simply disclose a method and a device for determination of the stability or storability of oil, wherein the stability of oil is determined by measuring the intensity of light scattering from the oil surface, when an asphaltene flocculating liquid is added to the oil sample for determining the stability of the oil. Thus, Tolvanen et al. does not contemplate a high throughput method for screening lubricating oil additive composition samples, under program control, for storage stability by “maintaining each lubricating oil additive composition sample comprising at least one lubricating oil additive at a predetermined temperature for a predetermined period of time, measuring the storage stability of the composition and outputting the results” as generally recited in appealed Claim 1. In contrast, Tolvanen et al. simply adds an asphaltene flocculating liquid to an oil and measures the intensity of light scattering from the oil surface. Accordingly, Tolvanen et al. teaches away from the presently claimed invention. As such, even by combining Kolosov et al.

with Tolvanen et al., one skilled in the art would not arrive at the high throughput method for screening lubricating oil additive composition samples, under program control, as presently recited in appealed Claim 1.

B. Appealed Claims 20-29 and 38 are non-obvious over Kolosov et al. and O'Rear or Tolvanen et al.

First, with respect to the rejection of appealed Claims 20-29 and 38 as obvious over Kolosov et al. in view of O'Rear or Tolvanen et al., the Board now states that O'Rear and Tolvanen are not removed from consideration in the rejection of Claims 20-29 and 38. Thus, appellants are now for the first time responding to the points they believe the Board misapprehended or overlooked in making this rejection based on Kolosov et al. in view of O'Rear or Tolvanen et al. Second, the Board is respectfully directed to the following paragraph beginning on line 1 of page 6 of the Board's decision:

“The Board found that Kolosov discloses a high throughput system for measuring numerous properties of lubricant compositions, including viscosity, thermal degradation, aging characteristics, and agglomeration or assemblage of molecules. The Board found that one of ordinary skill in the art would have found these properties useful in determining the storage stability of lubricant compositions. Decision 16:22-17:1; see also Decision 20:1-6. The Board also found that Kolosov contemplates measuring a parameter of a sample at a first time followed by measuring the parameter at a second time and so on during a predetermined period of time. Decision 7:7-10. On rehearing, the Appellants have not pointed to any error in these findings.”

Appellants respectfully believe that the following points in the above paragraph were misapprehended or overlooked. Contrary to the statement by the Board that Appellants have not pointed to any error in the findings that one of ordinary skill in the art would have found the properties disclosed in Kolosov et al. useful in determining the storage stability of lubricant compositions, Appellants have asserted that Kolosov et al. only disclose that the invention can be used to screen a lubricant for a variety of properties and provides no suggestion or motivation in Kolosov et al. of obtaining storage stability data by maintaining each sample at a predetermined temperature for a predetermined time and measuring the storage stability of each sample in a high throughput method. Thus, one skilled in the art would not even look to the disclosure of Kolosov

et al. to modify the method disclosed therein and arrive at the presently recited high throughput method for screening lubricating oil composition samples, under program control, of appealed Claim 20.

Furthermore, it is well established that there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 [82 USPQ2d 1385] (2007) (“To facilitate review, this analysis should be made explicit.”) (citing *Kahn*, 441 F.3d at 988). Instead, the Board simply maintains that one of ordinary skill in the art would have found the properties disclosed in Kolosov et al. useful in determining the storage stability of lubricant compositions and states no reasons of particularity as to why one skilled in the art would look to Kolosov et al. to measure storage stability of a composition containing a lubricating oil additive by “maintaining the each composition at a predetermined temperature for a predetermined period of time, measuring the storage stability of the composition and outputting the results”.

Third, the Board is respectfully directed to the following paragraph beginning on line 12 of page 6 of the Board’s decision:

The Examiner found that O’Rear and Tolvanen teach that it is common to measure the storage stability of lubricating oil compositions by maintaining the compositions at a certain temperature for a predetermined period of time. See Ans. 7-8. The Appellants have not pointed to any error in these findings.

We find that one of ordinary skill in the art would have recognized that maintaining a composition at a predetermined temperature for a predetermined time simulates storage conditions. Accordingly, we find that one of ordinary skill in the art would have found it useful to maintain the lubricant compositions disclosed in Kolosov at a predetermined temperature for a predetermined time prior to measuring properties related to storage stability. See *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742 (2007) (a person of ordinary skill is also a person of ordinary creativity, not an automaton).

Appellants respectfully believe that the following points in the above paragraph were misapprehended or overlooked. Contrary to the statement by the Board that Appellants have not pointed to any error in the findings that O'Rear and Tolvanen et al. teach that it is common to measure the storage stability of lubricating oil compositions by maintaining the compositions at a certain temperature for a predetermined period of time, Appellants have asserted that O'Rear is merely concerned with forming a blend of lube base oils wherein the lube base oil product has a greater stability in the absence of additives than the stability of the synthetic lube base oil and has a greater stability in the presence of additives than the non-synthetic lube base oil. Moreover, O'Rear further discloses (1) a Oxidation BN test for measuring resistance to oxidation of a composition containing a lube blend and additives by means of a Dornite-type oxygen absorption apparatus in which the compositions are subjected to one atmosphere of pure oxygen at 340°F and measured for the time it takes to consume 1000 ml of oxygen, i.e., a non automated test which is not carried out for a predetermined time; (2) Oxidator A test which uses the same apparatus as in the Oxidator BN test but the composition contains no additive, i.e., a non automated test which is not carried out for a predetermined time and the composition is a lube oil only; and (3) a method to study the stability of lube base oils during storage by monitoring floc and sediment formation when they are stored in an oven while exposed to air, i.e., a non automated test and the composition is a lube oil only. Accordingly, O'Rear provides no disclosure of testing a composition comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive for storage stability by "maintaining each composition at a predetermined temperature for a predetermined period of time, measuring the storage stability of the composition and outputting the results" as presently recited in appealed Claim 20. As such, even by combining Kolosov et al. with O'Rear, one skilled in the art would not arrive at the high throughput method for screening lubricating oil composition samples, under program control, as presently recited in appealed Claim 20.

Tolvanen et al. is no more relevant a reference than O'Rear. Tolvanen et al. simply disclose a method and a device for determination of the stability or storability of oil, wherein the stability of oil is determined by measuring the intensity of light scattering from the oil surface, when an asphaltene flocculating liquid is added to the oil sample for determining the stability of the oil. Thus, Tolvanen et al. does not contemplate a high throughput method for screening

lubricating oil composition samples, under program control, for storage stability by “maintaining each lubricating oil composition sample at a predetermined temperature for a predetermined period of time, measuring the storage stability of the composition and outputting the results” as generally recited in appealed Claim 20. In contrast, Tolvanen et al. simply add an asphaltene flocculating liquid to an oil and measures the intensity of light scattering from the oil surface. Accordingly, Tolvanen et al. teach away from the presently claimed invention. As such, even by combining Kolosov et al. with Tolvanen et al., one skilled in the art would not arrive at the high throughput method for screening lubricating oil composition samples, under program control, as presently recited in appealed Claim 20.

C. Appealed Claims 10-13 and 30-33 are
 non-obvious over Kolosov et al. in view of O'Rear
 or Tolvanen et al. and further in view of Garr et al.

With respect to the rejection of appealed Claims 10-13 and 30-33 as obvious over Kolosov et al. in view of O'Rear or Tolvanen et al. and further in view of Garr et al., the misapprehended or overlooked deficiencies of Kolosov et al., O'Rear and Tolvanen et al. discussed above with respect to the rejection of appealed Claims 1 and 20, from which Claims 10-13 and 30-33 ultimately depend, apply with equal force to this rejection. Garr et al. do not cure the deficiencies of Kolosov et al., O'Rear and Tolvanen et al. Specifically, Garr et al. do not disclose any automated storage stability testing of any material. Rather, Garr et al. simply disclose employing a bar code to identify individual containers. Thus, one skilled in the art would not even look to Garr et al. to arrive at the presently recited method set forth in appealed Claims 1 and 20, from which Claims 10-13 and 30-33 ultimately depend, by combining Kolosov et al., O'Rear or Tolvanen et al., with Garr et al. with any expectation of success. Only by using Appellants' disclosure as a guide has the Examiner been able to piece together the claimed invention which employs an automatic high throughput method to rapidly analyze and screen a diverse number of lubricating oil compositions for storage stability data.

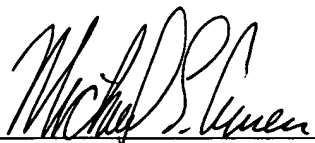
For the foregoing reasons, Appellants respectfully submit that appealed Claims 10-13 and 30-33 are not obvious over Kolosov et al. in view of O'Rear or Tolvanen et al. and further in view of Garr et al. Thus, appealed Claims 10-13 and 30-33 are allowable.

- D. Appealed Claims 14-17 and 34-37 are non-obvious over Kolosov et al. in view of O'Rear or Tolvanen et al. and further in view of Smrcka et al.

With respect to the rejection of appealed Claims 14-17 and 34-37 as obvious over Kolosov et al. in view of O'Rear or Tolvanen et al. and further in view of Smrcka et al., the misapprehended or overlooked deficiencies of Kolosov et al., O'Rear and Tolvanen et al. discussed above with respect to the rejection of appealed Claims 1 and 20, from which Claims 14-17 and 34-37 ultimately depend, apply with equal force to this rejection. Smrcka et al. do not cure the deficiencies of Kolosov et al., O'Rear and Tolvanen et al. Specifically, Smrcka et al. do not disclose any automated storage stability testing of any material. Rather, Smrcka et al. simply disclose storing test results in a data carrier. Thus, one skilled in the art would not even look to Smrcka et al. to arrive at the presently recited method set forth in appealed Claims 1 and 20, from which Claims 14-17 and 34-37 ultimately depend, by combining Kolosov et al., O'Rear or Tolvanen et al., with Smrcka et al. with any expectation of success. Only by using Appellants' disclosure as a guide has the Examiner been able to piece together the claimed invention which employs an automatic high throughput method to rapidly analyze and screen a diverse number of lubricating oil compositions for storage stability data.

For the foregoing reasons, Appellants respectfully submit that appealed Claims 14-17 and 34-37 are not obvious over Kolosov et al. in view of O'Rear or Tolvanen et al. and further in view of Smrcka et al. Thus, appealed Claims 14-17 and 34-37 are allowable.

Dated: May 14, 2008

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